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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/676,861	09/30/2003	Tatsuki Wade	SANKY P-242 / 500615.2020	7638
26418	7590	07/10/2006	EXAMINER	
REED SMITH, LLP ATTN: PATENT RECORDS DEPARTMENT 599 LEXINGTON AVENUE, 29TH FLOOR NEW YORK, NY 10022-7650			WATKO, JULIE ANNE	
			ART UNIT	PAPER NUMBER
			2627	

DATE MAILED: 07/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/676,861

Applicant(s)

WADE, TATSUKI

Examiner

Julie Anne Watko

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06/13/2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Drawings***

1. The drawings were received on June 13, 2006. These drawings are acceptable.

### ***Claim Rejections - 35 USC § 103***

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Claims 1-2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Horita et al (US PAP No. 2002/0141323 A1) in view of Kamata et al (JP 03-144924 A).

As recited in claims 1-2, Horita et al show an optical head device comprising: a lens holder in which an objective lens and drive coils are mounted; a plurality of elastic support members which support said lens holder to move in a focusing direction and a tracking direction; said lens holder having a coil holding portion for holding said drive coils and a lens holding portion which projects from said coil holding portion to the front to hold said objective lens; and said lens holding portion being formed thinner than said coil holding portion to avoid interference with a deflecting element positioned beneath said lens holding portion,

As recited in claim 1, Horita et al show (inherently) gathering vibrations in the focusing direction at a front end portion of the lens holding portion, and having a first vibration-absorbing member attached to the front end portion thereof.

As recited in claim 1, Horita et al are silent regarding an attaching face of the first vibration absorbing member is formed in the focusing direction so as to absorb the vibrations in the focusing direction, and a flat surface with an arc shape from the side portion to the front along the outer circumference of said objective lens.

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Regarding “arc shape”: There is no invention in changing the shape of a known apparatus, absent unexpected results due to the claimed shape, provided that the claimed shape is within the level of ordinary skill in the art. In re Daily, 357 F.2d 669, 149 USPQ 47 (CCPA 1966). Applicant has provided no evidence of unexpected results due to the claimed shape, and has not demonstrated that the claimed shape was beyond ordinary skill in the art.

As recited in claim 1, Kamata et al show that an attaching face (on which surface the acrylic system both-side adhesive tape 7 is formed) of a vibration absorbing member 4-1 is formed in the focusing direction so as to absorb the vibrations in the focusing direction (see page 2, upper right, 2<sup>nd</sup> full paragraph, which teaches that acrylic type double sided adhesive tape 7 is only on a surface parallel to excitation resonance direction based upon controlling movement of the objective lens, wherein focus control is up/down movement as taught on page 2, lower left, first full paragraph).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the attaching face of Horita et al only on a surface parallel to a surface parallel to excitation resonance direction based upon focus controlling movement of the objective lens as taught by Kamata et al. The rationale is as follows: one of ordinary skill in the art would have been motivated to relieve or eliminate high-order resonance as taught by Kamata et al (see English ABSTRACT).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to arrive at the claimed shape in the process of routine design choice as is notoriously well known in the art. The rationale is as follows: one of ordinary skill in the art would have

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been motivated to provide sharp edges that could injure a worker during assembly as is notoriously well known in the art.

As recited in claim 2, in addition to the above teachings, Horita et al show (inherently) gathering vibrations in the tracking direction at a border between said coil holding portion and said lens holding portion.

As recited in claim 2, Horita et al are silent regarding at least one second vibration-absorbing member being provided at the border between said coil holding portion and said lens holding portion such that an attaching face of the second vibration absorbing member is formed in the tracking direction so as to absorb the vibrations in the tracking direction.

Regarding the limitation, “at the border between said coil holding portion and said lens holding portion”: There is no invention in relocating known parts. In re Japikse, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950). Applicant has not demonstrated that the location was outside the level of ordinary skill in the art, nor that the functioning of the apparatus is changed by the relocation.

Regarding the limitation, “second”: There is no patentable significance to the mere duplication of parts unless a new and unexpected result is produced. In re Harza, 274 F.2d 669, 124 USPQ 378 (CCPA 1960).

As recited in claim 2, Kamata et al show a vibration-absorbing member 4-1 being provided such that an attaching face of the vibration absorbing member is formed in the tracking direction (see page 2, upper right, 2<sup>nd</sup> full paragraph, which teaches that acrylic type double sided adhesive tape 7 is only on a surface parallel to excitation resonance direction based upon controlling movement of the objective lens, wherein tracking control is rotary movement as

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taught on page 2, lower left, first full paragraph) so as to absorb the vibrations in the tracking direction.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the attaching face of Horita et al only on a surface parallel to a surface parallel to excitation resonance direction based upon tracking controlling movement of the objective lens as taught by Kamata et al. The rationale is as follows: one of ordinary skill in the art would have been motivated to relieve or eliminate high-order resonance as taught by Kamata et al (see English ABSTRACT).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to add a second vibration-absorbing member in the claimed location. The rationale is as follows: one of ordinary skill in the art would have been motivated to increase a vibration-absorbing effect and to prevent transmission of vibrations between parts of the head as is notoriously well known in the art.

4. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Horita et al (US PAP No. 2002/0141323 A1) in view of Kamata et al (JP 03-144924 A) as applied to claims 1-2 above, and further in view of Naraoka et al (JP 2005-538062).

Horita et al show a head as described above for claims 1-2.

As recited in claim 3, Horita et al are silent regarding an arc shape from the side portion to the front along the outer circumference of said objective lens.

See teachings, rationale and motivations above for claim 1.

As recited in claim 3, Horita et al are silent regarding a first shock-absorbing member attached to the front end portion thereof.

As recited in claim 3, Naraoka et al teach the addition of shock-absorbing members to a head in order to increase reliability.

Furthermore, There is no invention in relocating known parts. In re Japikse, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950). Applicant has not demonstrated that the location was outside the level of ordinary skill in the art, nor that the functioning of the apparatus is changed by the relocation.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to add a shock-absorbing member to the claimed location. The rationale is as follows: one of ordinary skill in the art would have been motivated to improve apparatus reliability as taught by Naraoka et al and as is notoriously well known in the art.

#### ***Response to Arguments***

5. Applicant's arguments with respect to claims 1-3 have been considered but are moot in view of the new ground(s) of rejection.

#### ***Conclusion***

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julie Anne Watko whose telephone number is (571) 272-7597. The examiner can normally be reached on Monday through Thursday, noon to 10PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dwayne D. Bost can be reached on (571) 272-7023. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Julie Anne Watko, J.D.  
Primary Examiner  
Art Unit 2627

July 5, 2006  
JAW

A handwritten signature in black ink, appearing to read 'JAW', is written over the printed name and title of the examiner.